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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/609,931  | 06/30/2000  | Jay S. Walker        | 99-099              | 2766             |
| 22927   | 7590        | 07/06/2006           | EXAMINER            |                  |
| WALKER DIGITAL<br>2 HIGH RIDGE PARK<br>STAMFORD, CT 06905 |             |                      | FISCHER, ANDREW J   |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3627                |                  |

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/609,931

Applicant(s)

WALKER ET AL.

Examiner

Steven B. McAllister

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-24,27-30 and 33-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-24,27-30 and 33-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Note Regarding Examination***

In the prior Office Action, it was stated that “the statements that the subject matter is old and well known are taken to be admitted prior art since an adequate traversal of the statements was not presented in the replies subsequent to those actions. The traversals were not adequate because no statement was made as to why the noticed subject matter is not considered old and well known in the art.”

The holding that old and well known subject matter is taken to be admitted prior art is withdrawn in this action.

However, The traversals up to this point are not adequate because no statement was made as to *why* the noticed subject matter is not considered old and well known in the art. While Applicant has provided legal arguments as to why the Official Notice is improper, a statement as to why the subject matter is not considered old and well known has not been provided. It is noted that a statement that the inventor, assignee, and attorney are not aware of the existence of the subject matter prior to the application date would be satisfactory.

### ***Election/Restriction***

In light of Applicant's arguments and light of new claim 36 which is not patentably distinct from claim 30, the restriction requirement is withdrawn and all claims are herein considered.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10, 15-18, 27, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 is unclear because it is not clear to which transaction “the transaction” refers. It is assumed to refer to the present transaction.

As to claims 15-18, 27 and 29, claim 15 is indefinite because it depends from canceled claim 2.

***Double Patenting***

Claims 1, 2, 5, 8, 14, 15, 22, 24, 27, 30, 35 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 20-29 of U.S. Patent No. 5,926,796 in view of Fredregill et al (6,138,911) and Rongley (5,758,322).

As to claims 1 and 30, '796 shows receiving customer transaction information at a processing device; identifying a query based on the customer information; outputting the query; receiving a response; and analyzing the response (to determine whether the customer wants a full subscription).

'796 does not show that the query is outputted by prompting the attendant to present it, or that the processing device performs the response analysis on a verbal response.

Fredregill shows outputting a query by prompting the attendant to present the query. It would have been obvious to one of ordinary skill in the art to modify the method of '796 by outputting the query as taught by Fredregill in order to provide a human interface.

As to analyzing the verbal response via a processor, Rongley shows this element. It would have been obvious to one of ordinary skill in the art to further modify the method of '796 as taught by Rongley in order to provide enhanced retail efficiency.

As to claim 3 and 4, '796 in view of Fredregill and Rongley show all elements (it is noted that as claimed "outputting an indication of that at least second query" can be interpreted as asking the question).

As to claims 5, 8, 14, 19, 22 and 24, all elements are shown by '796.

As to claim 35, '796 in view of Fredregill and Rongley show (as shown above) receiving at a first processing device first customer information including information identifying a first product; selecting a query based at least in part on the first product (comprising whether the customer would like a subscription); prompting the attendant to present the question; receiving a verbal response. The claims of '796 further show analyzing the response to determine if a mediation response is required (comprising e.g., determining whether the transaction type needs to be changed from a single copy

to a subscription and the subscription process carried out); and instructing the attendant to perform the remediation. (It is noted that it is inherent that the attendant is instructed to present the response since in '796 doing so is part of his job, so upon making the determination that it is appropriate to carry out the subscription process, he is instructed by the management and the terms of his employment to do so.)

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-8, 10-12, 14-16, 19-21, 23, 24, 27, 30, 35, 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Brockman et al (5,826,240).

Brockman shows receiving customer information at a processing device; identifying a query based at least in part on customer information; prompting an attendant to present a query; receiving a verbal response; and analyzing the verbal response by the processing device (since the processing device uses voice recognition for data input – col. 5, 50-56). (see e.g., col 6, lines 39-48 for the process).

As to claims 3 and 4, Brockman shows identifying, outputting and receiving and analyzing responses to multiple queries.

As to claims 5 and 6, Brockman shows using transaction information indicating complete transactions (e.g., col. 4, lines 42-48).

As to claims 7 and 8, Brockman further shows transaction including identifying the start of a transaction and information from a current transaction.

As to claim 10, Brockman further identifying the query based in part on customer information unrelated to the transaction. (It is noted that in this claim "the transaction" is interpreted as meaning the present transaction).

As to claims 11, 12, 14, Brockman further shows basing the query on the identifying of the customer by the attendant (e.g., identifying his identity and that he is a repeat customer, for instance).

As to claim 15, Brockman further shows generating output data based on the response and categorizing the data (e.g., based on the response, determining that the customer is a repeat customer, or that the customer is a likely prospect for first time buyer financing.)

As to claim 16, Brockman shows identifying a second query (e.g, would the buyer like first time financing); prompting the attendant and receiving a response.

As to claims 20 and 28, Brockman shows review of the queries presented by the attendant (e.g., col. 8, lines 20-30). It inherently shows compensating him for properly performing the task, since he is paid for presenting the queries.

As to claim 23, Brockmans shows selectively recording the response (col. 8, lines 8-30).

As to claims 30 and 36, Brockmans shows all elements noted above and further shows determining whether the at least one query satisfies a timing condition associated with the merchant and prompting the attendant to the attendant to present the offer if the timing condition is satisfied (e.g., whether the sale is taking place within a certain period of time after the birth of the prospect – see col. 6, lines 38-49, the system determining if the prospect is young and offering first time financing if he is).

Regarding claims 27 and 35, Brockman shows receiving at a processing device, first information from a customer including information identifying a product (the car); selecting a query based on the information; prompting an attendant to present the customer; receiving a verbal response comprising an offer (see col. 8, lines 60-68); analyzing the verbal response to determine if a remediation response is required (analyzing the response to see if the offer is acceptable or is a counteroffer is required); and instructing the attendant to perform the remediation response (communicating the counteroffer residing on the processor to the buyer – col. 8, lines 60-68).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



Claims 1, 3-5, 7, 8, 11-17, 19, 20, 22-24 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over '911.

'911 shows receiving customer transaction information; identifying a query based on the customer information; outputting the query; prompting an attendant to present the query; and receiving a verbal response (e.g., whether the customer wants to use points to reduce the price of a redemption item). (see e.g., col. 11, lines 37-55)

'911 does not explicitly show that the verbal response is analyzed by the processing device.

Rongley shows analyzing a verbal response by a processing device. It would have been obvious to one of ordinary skill in the art to modify the method of '911 by analyzing the verbal response by the processor in order to allow hands free processing of the response, making the process more efficient (col.1, lines15-25).

As to claims 22 and 24, all elements are shown by '911.

As to claims 5, 7, 8, 11 and 14, '911 in view of Rongley shows all elements.

As to claim 9, the Fredregill shows that the query is based at least in part in information from a previous visit (accrued points, etc.).

As to claim 12, customer information identifying the customer is identified by the attendant, since he enters it.

As to claim 15, output comprising whether or not to apply the points to the purchase, based on the verbal response to the query, and categorizing the output as to yes or no.

As to claim 19, Fredregill in view of Rongley shows identifying the attendant (shown in Rongley).

As to claim 3, '911 shows all steps except identifying a second query, outputting a second question, receiving and analyzing a second response. However, the examiner takes official notice that it is notoriously old and well known in the art to identify, ask, receive answers to, and analyze a plurality of questions. It would have been obvious to one of ordinary skill in the art to modify the method of '911 by doing so in order to enable handling of transactions where more than one redemption item is purchased, thereby allowing the customer to use his bonus points on more than one item.

As to claim 13, '911 shows all elements of the claim except that identifying the query is based at least in part on the authority level of the attendant. However, the examiner takes official notice that it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to modify the method of '911 by doing so in order to avoid large losses caused by an inexperienced person having a low authority level.

As to claims 16 and 17, '911 shows all elements of the claims except identifying a second query based on the categorizing of the output data of the first; prompting an attendant to present the second; and receiving and analyzing the verbal response. However, the examiner takes official notice that it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to modify the method of '911 by doing so in order to facilitate the more flexible use of points.

As to claims 20 and 28, '911 shows all elements of the claim except analyzing if the attendant properly presented the query. However the examiner takes official notice that to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method of '911 by analyzing whether the attendant properly presented the query in order to ensure that the customer receives the proper messages. Regarding compensating the attendant for properly presenting the query, it is noted that it is inherent that attendant is compensated for the proper performance of his duties, including proper presentation of the queries.

As to claim 23, '911 shows all elements of the claim except receiving a response comprising selectively recording the response. However the examiner takes official notice that to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method of '911 by receiving a response comprising selectively recording the response in order to permit machine analysis of the response and to save the interchange for later quality control analysis.

Claims 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over '911 in view of Rongley as applied to claim 1, and further in view of Plainfield et al (5,893,075).

'911 in view of Rongley show all elements of the claim except that the questions are survey questions. Plainfield et al show the use of survey questions. It would have been obvious to one of ordinary skill in the art to modify the method of '911 by having

the system select a survey question in order to better serve the customer and to better focus marketing efforts.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over '911 in view of Rongley as applied to claim 1 and further in view of the [www.atpos.com](http://www.atpos.com) webpages.

The method of '911 shows all elements of the claim except receiving customer information via a portable computing device. [www.atpos.com](http://www.atpos.com) shows such a device. It would have been obvious to one of ordinary skill in the art to modify the method of '911 by providing such a device in order to read data from smart cards and so on and to provide portability so that the POS could be set up where needed.

Claims 17, 18, and 29 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Brockman et al.

As to claims 17 and 18, Brockman shows analyzing the verbal response and generating output data based on the response and categorizing the data.

Alternatively, as to claims 17 and 18, Brockman does not explicitly show analyzing the verbal response and generating output data based on the response and categorizing the data. However, the examiner takes official notice that it is notoriously

Art Unit: 3627

old and well known to analyze, and generate output based a response and categorize the data.

As to claim 29, Brockman shows reviewing and analyzing the actions of the attendant (col. 8, lines 20-28) and since the presentation of the counteroffer is one of the actions of the attendant, it shows reviewing and analyzing the presentation of these. As to compensating the attendant for properly performing the task, since the presenting the remediations (counteroffers) is part of his job and he is paid for the job, he is paid for properly presenting them.

Alternatively, as to claim 29, Brockman does not explicitly show analyzing the proper presentation of the remediation responses. However, the examiner takes official notice that it is notoriously old and well known to analyze whether an employee is properly performing his actions (in this case presenting remediation responses – the counteroffers). It would have been obvious to one of ordinary skill in the art to modify the method of Brockman by doing so in order to ensure that the employee is performing all steps of his job.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brockman et al.

Brockman et al shows all elements of the claims except selecting and presenting survey questions. However, the examiner takes official notice that it is notoriously old

Art Unit: 3627

and well known in the art to do so during the car buying process. It would have been obvious to one of ordinary skill in the art to modify the method of Brockman by presenting survey questions via its method in order to ensure that they are presented and in order to receive customer feedback.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

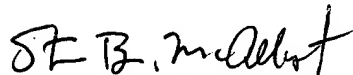
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (571) 272-6785. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander G. Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3627

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven B. McAllister

Steven B. McAllister  
Primary Examiner  
Art Unit 3627

**STEVE B. MCALLISTER**  
**PRIMARY EXAMINER**